



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/753,655

01/07/2004

John Lupoi

60092-0012

7214

29989

7590

04/28/2008

HICKMAN PALERMO TRUONG & BECKER, LLP  
2055 GATEWAY PLACE  
SUITE 550  
SAN JOSE, CA 95110

EXAMINER

SALCE, JASON P

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

04/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/753,655	<b>Applicant(s)</b> LUPOI ET AL.	
	<b>Examiner</b> Jason P. Salce	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-16 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-16 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/05-1/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 8/26/2005, 10/17/2005 and 1/24/2008 were filed after the filing date of the instant application on 1/7/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Election/Restrictions***

Claims 7-10, 17-20 and 27-30 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/24/2007. Claims 7-10, 17-20 and 27-30 have subsequently been cancelled by Applicant.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. At Paragraph 0306 of Applicant's specification, a machine-readable medium is defined as a transmission media (signal), which is non-statutory subject matter (see MPEP 2106).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 11-16 and 21-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Erdelyi (U.S. Patent No. 6,631,522).

Referring to claim 1, Erdelyi discloses method for indexing motion video (**see Abstract, Title and Column 4, Lines 33-34**), receiving, through a network communication link, data that indicates a segment of a motion video file and in response to receiving the information, establishing an association between the motion video file and the data (**see Figure 2 for a GUI that allows a user to select option 101 (Encoder 1)**, which at Column 13, Lines 48-62 and Figure 7 allow the user (**through the GUI**) to mark videos into segments using In and Out points and in response to marking the video clip into segments, storing the association between the In and Out point and video clip into a database (see Column 13, Lines 63-65) for future reference by an End-User GUI (*option 110 in Figure 2*)).

Referring to claim 2, Erdelyi discloses a method for indexing motion video that includes sequentially displaying one or more frames of a motion video file (**see the rejection of claim 1**).

Erdelyi also discloses receiving, through a network communication link, first user input at a first time (**see the rejection of claim 1 for setting an “In” Point**).

Erdelyi also discloses that the method further includes that in response to receiving the first user input, storing a first timestamp that is associated with a first frame of the motion video file (**see again Column 13, Lines 63-65**), wherein the first frame was displayed at the first time (**see Figure 7 for setting the “In” point during display of the video clip on the "Display Screen", therefore teaching that a stored “In” point time in the database representing when a first frame was displayed**).

Erdelyi also discloses that the method includes receiving, through a network communication link, second user input at a second time that differs from the first time (**see again Column 48-62 and Figure 7 for further setting an “Out” Point**).

Erdelyi also discloses the method includes that in response to receiving the second user input, storing a second timestamp that is associated with a second frame of the motion video file (**see again Column 13, Lines 63-65**), wherein the second frame was displayed at the second time (**see Figure 7 for setting the “Out” point during display of the video clip on the "Display Screen", therefore teaching that a stored “Out” point time in the database representing when a second frame was displayed**).

Erdelyi also discloses that the method further includes establishing a first association between the motion video file, the first timestamp, and the second timestamp (**see again Column 13, Lines 63-65 and Column 14, Lines 61-65 and for storing the first and second timestamp and a reference to the video clip in an ECL file**).

Referring to claim 3, Erdelyi further discloses receiving, through a network communication link, a request to receive a version of the motion video file (**see Column 8, Lines 53-59 for viewing a version (*portion*) of a video clip specified by the "In" and "Out" Points**).

Erdelyi also discloses that in response to receiving the request, sending, through a network communication link, information that instructs a motion video file player to display only selected frames of the motion video file, wherein the selected frames consist substantially of frames that are associated with timestamps that occur between the first timestamp and the second timestamp (**see again Column 8, Lines 53-59**).

Referring to claim 4, Erdelyi also discloses receiving, through a network communication link, third user input at a third time that differs from the first time (**see the rejection of claims 1-3 and further note Column 14, Lines 61-65 for storing multiple In and Out points for multiple video clips**).

Erdelyi also discloses that in response to receiving the third user input, storing a third timestamp that is associated with a third frame of the motion video file, wherein the

third frame was displayed at the third time (**see the rejection of claims 1-3 and further note Column 14, Lines 61-65 for storing multiple In and Out points for multiple video clips**).

Erdelyi also discloses receiving, through a network communication link, fourth user input at a fourth time that differs from the second time (**see the rejection of claims 1-3 and further note Column 14, Lines 61-65 for storing multiple In and Out points for multiple video clips**).

Erdelyi also discloses that in response to receiving the fourth user input, storing a fourth timestamp that is associated with a fourth frame of the motion video file, wherein the fourth frame was displayed at the fourth time (**see the rejection of claims 1-3 and further note Column 14, Lines 61-65 for storing multiple In and Out points for multiple video clips**).

Erdelyi also discloses establishing a second association between the motion video file, the third timestamp, and the fourth timestamp (**see the rejection of claims 1-3 and further note Column 14, Lines 61-65 for storing multiple In and Out points for multiple video clips**).

Referring to claim 5, see the rejection of claims 1-4.

Referring to claim 6, see the rejection of claims 1-5.

Referring to claims 11-16, see the rejection of claims 1-6, respectively.

Referring to claims 21-26, see the rejection of claims 1-6, respectively.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2623

Jason P Salce  
Primary Examiner  
Art Unit 2623

April 24, 2008